

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. Appln. No. 09/774,008

**REMARKS**

Claims 1-15 are pending in the application. By this amendment, new claims 13-15 are added and claims 1, 7 and 8 are independent.

As a preliminary matter, Applicant thank the Examiner for acknowledging receipt of the priority document and accepting the drawings filed with the application.

Turning to the merits, claims 2, 3, 5 and 7 are objected to because the Examiner maintains that the claims contain grammatical informalities. Applicant has amended the claims to improve clarity, as set out above, in order to overcome the objections.

Claims 1, 2, 5 and 8-12 are rejected under 35 U.S.C. § 102(e) as being anticipated by Voit (U.S. Patent No. 6,075,783; hereinafter "Voit"). Claims 3 and 4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Voit in view of Ray *et al.* (U.S. Patent No. 6,067,529; hereinafter "Ray"). Claims 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Voit in view of "Official Notice." Claim 7 is rejected under 35 U.S.C. § 103(a) as being anticipated by Curry *et al.* (U.S. 6,359,880; hereinafter "Curry") in view of Martin *et al.* (U.S. Patent No. 6,614,788; hereinafter "Martin"). Applicant's comments on the rejections follow. .

**Rejection of Claims 1, 2, 5 and 8-12 Under § 102(e) by Voit**

With regard to independent claim 1, Applicant submits that the claimed invention is patentable because each and every element of the claim is not disclosed or suggested by Voit. For example, claim 1 recites:

A method of performing an Internet protocol (IP)-based communication between wireless terminals, the method comprising the steps of:

- (a) receiving a request for an IP address of a second terminal from a first terminal;
- (b) upon receipt of the request, checking whether an IP address corresponding to the second terminal is registered; and
- (c) if the IP address is not registered, assigning an IP address to the second terminal corresponding to information from an IP address server.

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In Voit, however, there is no express disclosure of a request for an IP address of a second terminal from a first terminal, as recited in claim 1.

The section of Voit cited by the Examiner (col. 9, lines 8-11) discloses that “[a] caller at PC 10 enters a Domain Name Address or a telephone number,” and “[t]he PC 10 transmits a translation request message, containing the Domain Name Address or telephone number, to the modified Domain Name Server 13.” Next, the modified “Domain Name Server 13 produces the IP address, . . . , *but does not immediately send it back to the calling equipment*” (col. 9, lines 11-13). Instead of immediately sending the IP address to the caller, Voit discloses pinging the called PC 108, in a more detailed description of its operation at column 12, lines 6-43. If the called PC 108 is not live or is not taking calls, Voit discloses replying to the calling PC with the *IP address of a PSTN Gateway server* to reach a person’s wired telephone 170 or mobile communication device (col. 12, lines 30-38 and lines 38-42). In this case, Voit *does not* return the IP address of the called PC 108 or even the IP address of the wired telephone 170 or mobile communication device. Therefore, Voit does not even inherently disclose requesting the IP address of a second terminal from a first terminal, as claimed.

Moreover, the Examiner has not shown how Voit discloses, if the IP address is not registered, assigning an IP address to the second terminal corresponding to information from an IP address server, as recited in the claim. The section of Voit cited by the Examiner (col. 13, lines 11-25) makes no mention whatsoever of assigning an IP address to a wireless telephone.

For at least the above reasons, Applicant believes that claim 1 is patentable over Voit. Similarly, claims 2 and 5, which depend from claim 1, are patentable for at least the reasons as claim 1.

Applicant submits that claim 8 is patentable because Voit does not teach or suggest each and every element of the claim. Claim 8 recites:

A name server in an internet protocol (IP)-based communication system comprising:

a communication module unit . . . ;

a controller . . . ; and

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a database ....

In support of the rejection, the Examiner refers to the intelligent system 21 of the DNS computer (col. 9, lines 23-27) as purportedly disclosing the claimed communication module. Col. 9, lines 40-43 (referring to the intelligent system 21); col. 12, lines 58-62 (referring to the Domain Name Server or the ISCP). Furthermore, the Examiner refers to the entire Domain Name Server as being analogous to the claimed controller (col. 9, lines 18-27). Lastly, the Examiner makes another reference to a component of the Domain Name Server as purportedly disclosing the claimed database (col. 9, lines 30-33). In other words, the Examiner appears to improperly refer to two elements of the DNS and the DNS itself as disclosing the three distinct elements of claim 8. Applicant would argue that claim 8 is patentable because all elements are not arranged as required by the claim.

Applicant believes dependent claim 11 is patentable because the Examiner has not shown how the external devices include IP address servers. Claim 11 depends from claim 10 which recites that the communication module unit sends and receives IP-based data to and from external devices. In the rejection of claim 8, the Examiner refers to the an element of the Domain Name Server as purportedly disclosing the claimed communication module unit. The Examiner, however, fails to show how such an element of the Domain Name Server sends and receives IP-based data to and from external devices including IP address servers. Therefore, Applicant has amended claim 8 to incorporate claims 10 and 11.

Rejection of Claims 3 and 4 Under § 103(a) Over Voit in view of Ray

Applicant submits that claims 3 and 4, which depend from claim 1, are patentable for at least the reasons submitted for claim 1 and because Ray fails to make up for the deficiencies of Voit.

Rejection of Claim 6 Under § 103(a) Over Voit in view of Official Notice

Applicant submits that claim 6, which ultimately depends from claim 1, is patentable for at least the reasons submitted for claim 1.

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Rejection of Claim 7 Under § 103(a) by Curry in view of Martin

In the Office Action, the Examiner states that the claimed database is disclosed as the DNS system 51 (col. 9, lines 44-50) and the claimed controller is disclosed as the DHCP server (col. 18, lines 51-54) in Curry. Although the registration aspect of the claim is not disclosed by Curry, the Examiner cites Martin's disclosure of "updating of the directory service for the allocated IP address" (col. 2, lines 41-42) as corresponding to the claimed registering the assigned IP address in the database.

In view of the Examiner's rejection, Applicant has amended claim 7 as set out above to further define the invention for wireless terminals. Applicant argues that Curry does not teach or suggest any sort of IP address allocation process for communication between wireless terminals.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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\*Granted limited recognition under  
37 C.F.R. § 10.9(b), as shown in a copy of  
the same filed on September 15, 2004, at the

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